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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
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2424

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06/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/021,875	Applicant(s) KANO ET AL.	
	Examiner MICHAEL VAN HANDEL	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,11-15,26 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11-15,26 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/09/2009 has been entered.

Response to Amendment

2. This action is responsive to an Amendment filed 1/09/2009. Claims **1, 4-8, 11-15, 26, 29-34** are pending. Claims **1, 8, 26, 34** are amended. Claims **2, 3, 9, 10, 16-25, 27, 28, 35-56** are canceled.

Response to Arguments

3. Applicant's arguments regarding claims **1, 8, 26, and 34**, filed 1/09/2009, have been fully considered, but they are not persuasive.

Regarding claims **1, 8, 26, and 34**, the applicant argues that Patsiokas does not disclose the use of a preset key representing text. Please note the rejection of claims 1, 8, 26, and 34 under 35 USC 112, first paragraph below. The examiner fails to find support for the use of a preset key representing text within the context of the claims, as currently claimed. In the interest of expediting prosecution, the examiner interprets key information "representing text" to be

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information that holds some basis as text within the mind of the user. For example, even if the key information set by the user were a series of bits, the user may think of that series of bits as matching for "JPEG." Similarly, a user may think of a series of bits as a character string of 1s and 0s even though it is a series of high and low signals. With respect to this interpretation, Patsiokas discloses a user may indicate a desire to record a given selection via a record button. On receipt of the record signal from the user, the receiver checks for a record-ability flag provided by a content provider, and if the flag permits, the receiver retrieves the identifying (ID) codes pertaining to a selection currently being played or displayed and stores the code (col. 4, l. 48-63). A user's activation of a record signal may similarly hold textual representation in the mind of the user, as the user thinks of activating the signal as activating a "RECORD." Similarly, the checking for a record-ability flag of Patsiokas can be interpreted as checking to see if the least significant bit is a "1" or a "0" in order to determine the record-ability of a given selection (col. 6, l. 18-20).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims **1, 4-8, 11-15, 26, and 29-34** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **1, 8, 26, and 34**, the examiner fails to find support for the phrase “determining whether user preset key information *representing text* is included in the header portion of the additional information, the key information indicating a format of the payload of the data portion of the additional information” (italicized for emphasis), as currently claimed. Applicant cites p. 16, l. 15 – p. 17, l. 17 of Applicant’s specification as providing support for the amended phrase. Page 16, lines 19-20 states that the additional information may be in the form of text data. This portion of the specification refers to the additional information, not the key information, and thus is not relevant to the amended phrase. Page 16, lines 20-22 states that the key information may correspond to a character string which may be included in the payload of the additional information. P. 16, l. 23 – p. 17, l. 17 proceeds to describe how a user may enter key information to correspond to artist names; however, the examiner notes that this section describes matching key information to additional information within a data payload. P. 19, l. 15 - p. 20, l. 4 is the section of Applicant’s specification that corresponds to the claim language detailing that the user can set key information for matching with a format of the payload of the additional information stored in the additional information header. This section indicates that “[t]he additional information is, for example, of the type that includes a header portion and a data portion. The header portion includes information indicating the format, data length, etc. of the payload in the data portion. For example, if the payload in the data portion is a JPEG file, the header portion includes information indicating a JPEG file, the data length or the image size.” The section further indicates that “the user is allowed to set information which may be included

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in the header portion of the additional information, for example, information indicating the format of the payload in the data portion, as key information, so that only the payload in the data portion is stored on the PC.” Nowhere in this section does it state that the user preset key information with reference to the header represents text. For example, the user preset key information could be matched as a flag or series of bits indicating file format, data length, or image size. As such, the examiner fails to find support for the phrase, as currently amended.

Claims **4-7, 11-15, and 29-33** are rejected as being dependent on the above-mentioned independent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims **1, 5-8, 11-14, 26, 29-32, 34** are rejected under 35 U.S.C. 102(e) as being anticipated by Patsiokas.

Referring to claim **1**, Patsiokas discloses a method of storing additional information (see Abstract), the method comprising:

- receiving, from a receiver that receives a digital radio broadcast in which additional information is multiplexed with an audio program (col. 3, l. 38-39), the additional information thereof (col. 4, l. 31-41; col. 5, l. 63-67; col. 6, l. 1-26; & Figs. 6, 7); the

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- additional information having a data portion that includes a payload (song identifying (ID) code)(col. 4, l. 61-64 & col. 6, l. 21-26) and a header portion (record-ability flag) that includes information associated with the payload (col. 4, l. 57-60 & col. 6, l. 18-20);
- determining whether user preset key information representing text is included in the header portion of the additional information (col. 4, l. 48-63; col. 6, l. 55-61; & Fig. 5(b)), the key information indicating a format of the payload of the data portion of the additional information (whether the payload is recordable or not)(col. 4, l. 58-66 & col. 6, l. 55-61);
 - storing, from the additional information, only the payload of the data portion thereof in a storage medium only if the user preset key information is determined to be included in the header portion of the additional information (col. 4, l. 60-66; col. 6, l. 59-61; & Fig. 5(b)); and
 - deleting the additional information if the user preset key information is determined not to be included in the header portion of the additional information (col. 6, l. 58-59 & Fig. 5(b)).

Referring to claim 5, Patsiokas discloses the method of storing additional information according to claim 1, wherein storing step includes storing accompanying information in association with the additional information if the key information is determined to be included in the header portion of the additional information, the accompanying information including at least one of a timestamp (col. 2, l. 11), a user-provided tag, or a user-provided heading.

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NOTE: The USPTO interprets Applicant's "at least one of" language to be anticipated by a reference teaching any of the subsequent elements.

Referring to claim **6**, Patsiokas discloses the method of storing additional information according to claim 1, wherein said receiving step includes receiving, from the receiver, further additional information of a program other than the program that is received and transferred by the receiver (col. 5, l. 1-2 & col. 7, l. 3-10).

Referring to claim **7**, Patsiokas discloses the method of storing additional information according to claim 1, further comprising transferring the stored payload of the data portion of the additional information to said receiver, wherein said receiver displays the transferred additional information on a display unit thereof (col. 2, l. 12-14 & col. 5, l. 1-2).

Referring to claim **8**, Patsiokas discloses a method of transferring additional information, the method comprising:

- receiving a digital radio broadcast in which additional information is multiplexed with an audio program (col. 3, l. 38-39), thereby obtaining the additional information (col. 4, l. 31-41; col. 5, l. 63-67; col. 6, l. 1-26; & Figs. 6, 7); the additional information having a data portion that includes a payload (song identifying (ID) code)(col. 4, l. 61-64 & col. 6, l. 21-26) and a header portion (record-ability flag) that includes information associated with the payload (col. 4, l. 57-60 & col. 6, l. 18-20);
- determining whether user preset key information representing text is included in the header portion of the additional information (col. 4, l. 48-63; col. 6, l. 55-61; & Fig. 5(b)), the key information indicating a format of the payload of the data portion of the

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- additional information (whether the payload is recordable or not)(col. 4, l. 58-66 & col. 6, l. 55-61);
- transferring the additional information to an external device only if the key information is determined to be included in the header portion of the additional information (col. 4, l. 66-67; col. 5, l. 3-30); and
 - deleting the additional information if the user preset key information is determined not to be included in the header portion of the additional information (col. 6, l. 58-59 & Fig. 5(b)).

Referring to claim **11**, Patsiokas discloses the method of transferring additional information according to claim 8, wherein said transferring step includes transferring, in addition to the additional information including the key information, main information of the associated program to the external device if the key information is determined to be included in the header portion of the additional information (col. 5, l. 3-35; col. 6, l. 62-67; & col. 7, l. 1-10).

Referring to claim **12**, Patsiokas discloses the method of transferring additional information according to claim 8, wherein said receiving step includes receiving further additional information of a program other than the program being received (col. 5, l. 1-2 & col. 7, l. 3-10).

Referring to claim **13**, Patsiokas discloses the method of transferring additional information according to claim 8, further comprising receiving the payload of the data portion of the additional information from the external device and displaying the transferred additional information on a display unit (col. 5, l. 20-30).

Referring to claim **14**, Patsiokas discloses the method of transferring additional information according to claim 8, wherein said determining step includes storing the additional information in storage means if it is determined that the key information is included in the header portion of the additional information (col. 4, l. 60-66; col. 6, l. 59-61; & Fig. 5(b)), and said transferring step includes transferring the stored additional information to the external device at a predetermined timing (the song ID is transferred when the removable media is inserted into the reader)(col. 5, l. 3-15 & col. 6, l. 62-67).

Referring to claim **26**, Patsiokas discloses a receiver, comprising:

- a receiving unit which receives a digital radio broadcast in which additional information is multiplexed with an audio program (col. 3, l. 38-39); the additional information having a data portion that includes a payload (song identifying (ID) code)(col. 4, l. 61-64 & col. 6, l. 21-26) and a header portion (record-ability flag) that includes information associated with the payload (col. 4, l. 57-60 & col. 6, l. 18-20);
- a control unit which determines whether user preset key information representing text is included in the header portion of the additional information (col. 4, l. 48-63; col. 6, l. 55-61; & Fig. 5(b)), the key information indicating a format of the payload of the data portion of the additional information (whether the payload is recordable or not)(col. 4, l. 58-66 & col. 6, l. 55-61);
- a communications unit which transfers the additional information to an external device only if said control unit determines that the key information is included in the header portion of the additional information (col. 4, l. 66-67; col. 5, l. 3-30); and

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- said control unit deleting the additional information if the user preset key information is determined not to be included in the header portion of the additional information (col. 6, l. 58-59 & Fig. 5(b)).

Referring to claim **29**, Patsiokas discloses the receiver according to claim 26, wherein said communications unit transfers, in addition to the additional information including the key information, main information of the associated program to the external device if the key information is determined to be included in the header portion of the additional information (col. 5, l. 3-35; col. 6, l. 62-67; & col. 7, l. 1-10).

Referring to claim **30**, Patsiokas discloses the receiver according to claim 26, wherein said receiver unit also receives further additional information of a program other than the program being received (col. 5, l. 1-2 & col. 7, l. 3-10).

Referring to claim **31**, Patsiokas discloses the receiver according to claim 26, further comprising a display unit, wherein said communications unit receives the payload of the data portion of the additional information from the external device via said communications unit, the received payload of the data portion of the additional information being displayed on the display unit (col. 5, l. 1-2, 20-30).

Referring to claim **32**, Patsiokas discloses the receiver according to claim 26, further comprising storage means for storing the additional information, wherein the additional information is stored in said storage means if said control unit determines that the key information is included in the header portion of the additional information (col. 4, l. 60-66; col. 6, l. 59-61; & Fig. 5(b)), and said communications unit transfers the stored additional

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information to the external device at a predetermined timing (the song ID is transferred when the removable media is inserted into the reader)(col. 5, l. 3-15 & col. 6, l. 62-67).

Referring to claim **34**, Patsiokas discloses an information processing terminal, comprising:

- a data communications unit which receives, from a receiver capable of receiving a digital radio broadcast in which additional information is multiplexed with an audio program (col. 3, l. 38-39), the additional information thereof (col. 4, l. 31-41; col. 5, l. 63-67; col. 6, l. 1-26; & Figs. 6, 7); said additional information having a data portion that includes a payload (song identifying (ID) code)(col. 4, l. 61-64 & col. 6, l. 21-26) and a header portion (record-ability flag) that includes information associated with the payload (col. 4, l. 57-60 & col. 6, l. 18-20);
- a control unit which determines whether user preset key information representing text is included in the additional information (col. 4, l. 48-63; col. 6, l. 55-61; & Fig. 5(b)), the key information indicating a format of the payload of the data portion of the additional information (whether the payload is recordable or not)(col. 4, l. 58-66 & col. 6, l. 55-61);
- storage means which stored, from the additional information, only the payload of the data portion thereof in a storage medium only if said control unit determines that the user key information is included in the header portion of the additional information (col. 4, l. 60-66; col. 6, l. 59-61; & Fig. 5(b)); and

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- said control unit deleting the additional information if the user preset key information is determined not to be included in the header portion of the additional information (col. 6, l. 58-59 & Fig. 5(b)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patsiokas in view of Benyamin et al. (of record).

Referring to claim 4, Patsiokas discloses a method of storing additional information according to claim 1. Patsiokas further discloses downloading the audio selection associated with the ID from the Internet (col. 5, l. 31-35). Patsiokas does not specifically disclose storing the downloaded audio selection in the receiver memory. Benyamin et al. discloses a computer that is connected to Internet 128 via a modem. An Internet server 130 is provided via the Internet for downloading tracks, downloading information about tracks, etc. (col. 4, l. 29-35). A user inserts a disk cartridge into docking station 122 connected to the computer. The user then downloads tracks from the Internet to the disk cartridge (col. 4, l. 36-45). It would have been obvious to modify the system of downloading songs of Patsiokas to include storing the songs to the receiver memory, such as that taught by Benyamin et al. in order to allow a user to write songs to a music player's storage medium (Benyamin et al. col. 1, l. 27-31).

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10. Claims **15**, **33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Patsiokas.

Referring to claims **15** and **33**, Patsiokas discloses the method of transferring additional information/receiver according to claims 8 and 26, respectively, wherein said determining step includes storing the additional information in storage means if it is determined that the key information is included in the header portion of the additional information (col. 4, l. 60-66; col. 6, l. 59-61; & Fig. 5(b)). Patsiokas further discloses transferring the song ID to a computer (col. 5, l. 3-15 & col. 6, l. 62-67). Patsiokas does not specifically disclose deleting the stored additional information from the storage means after the additional information has been transferred to the external device; however, the examiner takes Official Notice that it was notoriously known in the prior art at the time that the invention was made to delete information on a storage medium after the information has been transferred. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transfer of the song ID in the system of Patsiokas to include deleting the song ID after the transfer has completed, such as that taught by the prior art in order to save storage space.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit
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MVH